

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

MAY 3, 1999

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Michael Khadivar

Serial No. 74/552,579

Robert S. Beiser of Michael, Best & Friedrich, LLP for
Michael Khadivar

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael Szoke, Managing Attorney)

Before Seeherman, Chapman and Bucher, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Michael Khadivar has appealed from the final refusal
of the Trademark Examining Attorney to register the
asserted mark shown below:

for "compact disc players."¹ The application includes the following description of the mark: "The mark consists of a three-dimensional configuration of a compact disc player." By Examiner's Amendment (dated October 20, 1995) the following statement was added to the application: "The matter shown in dotted lines on the drawing represents the position of control mechanisms and is not part of the mark." The application was originally based on a bona fide intention to use the mark in commerce. The asserted mark was published for opposition on August 8, 1995. A notice of allowance issued on January 16, 1996, and applicant filed a statement of use with claimed dates of first use and first use in commerce of October 1995.²

The Examining Attorney finally refused registration on the basis that the applied-for mark is de jure functional, and that it is not inherently distinctive under Sections 1, 2, and 45 of the Trademark Act, 15 USC §§1051, 1052 and 1127. In an Office action dated November 26, 1997, the Examining Attorney withdrew the refusal to register on the

¹ Application Serial No. 74/552,579, filed July 13, 1994.

² The Board notes that there are some differences between the applied-for mark and the configuration as shown in the specimens of record. Inasmuch as the Examining Attorney accepted applicant's statement of use, we presume that the Examining Attorney believes the drawing is a "substantially exact representation of the mark" as actually used as evidenced by the specimens in accordance with Trademark Rule 2.51(a)(2).

basis of de jure functionality, but otherwise denied applicant's request for reconsideration.

Briefs have been filed³, but an oral hearing was not requested by applicant.

The only issue before the Board is whether the applied-for mark is inherently distinctive; that is, does it function as a trademark.⁴

Applicant describes his applied-for mark as follows:

Applicant's design consists of a vertically oriented, two panel arrangement, a number of control knobs located on either side of the upper windows (sic-window?), and a door positioned directly below the upper windows (sic-window?). (brief, p. 11)

The Examining Attorney's position is essentially that

³ On February 11, 1998 applicant filed his reply brief, with exhibits i - xi attached thereto. In a Board order dated June 11, 1998, applicant was advised that any additional evidence attached to the reply brief would not be considered. See Trademark Rule 2.142(d). Accordingly, those exhibits not previously of record were not considered in our decision.

⁴ The Examining Attorney's final refusal was dated April 4, 1997. On October 6, 1997, applicant filed an appeal and a request for reconsideration; and on October 30, 1997 the Board suspended the appeal and remanded the application to the Examining Attorney for action on the request for reconsideration. The Examining Attorney denied the request for reconsideration on November 26, 1997. On December 5, 1997 applicant filed his brief on appeal. On December 29, 1997 applicant filed a response to the Examining Attorney's November 26, 1997 action, even though the Office action did not invite nor require a response. The December 29, 1997 paper included this statement: "Applicant's mark has acquired secondary meaning" and applicant offered information about secondary meaning. (pp. 5-6). This assertion of acquired distinctiveness is untimely, and will not be considered by the Board. See Trademark Rule 2.142(d), and TBMP §1215.

the asserted mark for a compact disc player is not unique and has nothing distinctive about it; that all such products have windows, display panels, doors and buttons located in various places on the players; and that purchasers will not perceive the configuration as a trademark or source indicator.

The Examining Attorney has made of record photocopies of several advertisements showing various compact disc players. While none shows exactly the same configuration as applicant's applied-for mark, they nonetheless show designs all of which include buttons, knobs, doors, windows and panels; further, a few of the designs show a more vertical than horizontal configuration.

Applicant, on the other hand, argues that it is the first and only entity in the industry offering this particular design; that the vertical orientation of the design, and particularly the narrow depth of the housing compared to the size of the vertical panel (which makes it suitable for wall mounting), is arbitrary, as is the overall design configuration, and the specific components which create the overall design; and that the configuration

is a nonfunctional shape which distinguishes applicant's product from those of other manufacturers.⁵

This Board previously had occasion to consider the question of inherent distinctiveness in relationship to a configuration in the case of *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992), involving the configuration of a floor mat for "plastic mats for use under chairs." The applicant argued that its applied-for mark was "unique" because there was no evidence that others used the identical design configuration for chair mats. However, there was evidence showing uses of fairly similar chair mats. As stated by the Board in *Robbins*, *supra*, at 1542-1543:

Thus, while applicant's applied for design may be unique in the sense that it is a "one and only," the record demonstrates that said design is not unique in the sense it has an "original, distinctive, and peculiar appearance." *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140 (CCPA 1960) quoting with approval from *Ex Parte Haig & Haig, Ltd.*, 118 USPQ 229, 230 (Asst. Comm. 1958). In other words, the record demonstrates that applicant's applied for design is not inherently distinctive or unique in the sense that the term "distinct" is defined as "clearly perceived or marked off" or "unmistakable," or in the sense that the term "unique" is defined as "highly

⁵ Applicant submitted a photocopy of his application for a design patent; however, although applicant stated that he received said design patent, a copy of the patent as issued was never submitted.

unusual, extraordinary." *Webster's New World Dictionary of the American Language* (2d ed. 1970).

If the concept of inherent distinctiveness was defined as meaning simply "one and only," then one could obtain a registration for a design which, while "unique" in this sense, differed only slightly from the designs of other competing products and /or containers. There would be no need that the applied for design have an "original, distinctive and peculiar appearance" as required by the *Haig & Haig* ("Pinch bottle") and *McIlhenny* ("Tabasco bottle") cases.

Thus, the essential criterion of an inherently distinctive mark is that it is immediately recognizable by consumers as a source indicator.

In the present case, although applicant may be the only party in his industry offering this particular configuration, the design is not unique or unusual in the sense described in the Robbins case. Instead, the configuration applied for by applicant consists of very ordinary components that go into any compact disc player from any manufacturer. How these components are arranged by applicant remains ordinary, and is not unusual. Applicant's design is nothing more than an arrangement of all the components involved in a compact disc player put together in a rather ordinary manner. The record before us

does not demonstrate that applicant's applied-for mark is inherently distinctive.⁶

Applicant's claim that the narrow depth of the housing is an unusual and discernible design feature is not persuasive. As applicant himself has pointed out, and as is shown and described in applicant's specimens of record, the purpose of the narrow depth of the unit vis-a-vis the length is so that the unit can be mounted on a wall, rather than free-standing.⁷ The purchasing public would readily perceive this configuration as making the product suitable for wall mounting.⁸

Accordingly, we find that applicant's configuration is not immediately recognizable as a distinctive way of identifying the source of applicant's goods. Rather,

⁶ We point out that in cases involving the issue of inherent distinctiveness of trade dress, background designs, and color, the Board and many courts have utilized the test set forth in the case of *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). See also, *Tone Brothers Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994); *In re Sunburst, Inc.*, __ USPQ2d __, Serial No. 74/300843, (TTAB March 31, 1999); *In re File*, 48 USPQ2d 1363 (TTAB 1998); *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253 (TTAB 1998); and *In re Hudson News*, 39 USPQ2d 1915 (TTAB 1996), *aff'd* in decision without published opinion, 1997 U.S. App. LEXIS 15556 (Fed. Cir. June 12, 1997).

⁷ We note that applicant stated in his reply brief (p. 4) that "No other design is vertically oriented and suitable for attractive wall mounting."

⁸ Obviously, applicant cannot argue that the depth/length ratio of the configuration is superior for wall mounting the compact disc player since that would be an admission that that portion of the claimed configuration was *de jure* functional.

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purchasers will look upon applicant's design as the configuration of applicant's product, and not as an indicator of the source of the goods.

Decision: The refusal to register is affirmed.

E. J. Seeherman

B. A. Chapman

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial and
Appeal Board